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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HUBERT HELAINE and FRANCE DERVAUX

Appeal 2009-002241
Application 09/918,501
Technology Center 2600

Decided: September 14, 2009

Before JOSEPH F. RUGGIERO, MAHSHID D. SAADAT,
and CARLA M. KRIVAK, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1-16, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (filed January 15, 2008), the Answer (mailed April 4, 2008), and the Reply Brief (filed June 4, 2008) for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants' Invention

Appellants' invention relates to enabling a user who subscribes to both a mobile telephone service and a landline telephone service to access associated services in a transparent manner from the same handset or terminal in the same way. (*See generally* Spec. 2:8-15).

Representative claim 1 is reproduced as follows:

1. An automatic network services management method comprising:
connecting a communication terminal of a first network to a private base;
connecting said private base to a second network; and
a correspondence memory establishing a correspondence between service codes of said first network and service codes of said second network.

The Examiner's Rejection

The Examiner's Answer cites the following prior art references:

Vanden Heuvel	US 5,924,014	Jul. 13, 1999
Shah	US 6,029,065	Feb. 22, 2000

Buhrmann	US 6,035,193	Mar. 7, 2000
Kamperschroer	US 6,434,399 B1	Aug. 13, 2002 (filed Aug. 27, 1998)
Sipilä	EP 0 748 136 A1	Dec. 11, 1996

Claims 1, 2, 9, and 12-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Buhrmann in view of Shah.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Buhrmann in view of Shah and Sipilä.

Claims 4, 6, and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Buhrmann in view of Shah, Sipilä, and Kamperschroer.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Buhrmann in view of Shah, Sipilä, Kamperschroer, and Vanden Heuvel.

Claims 8, 10, and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Buhrmann in view of Shah and Kamperschroer.¹

ISSUE

The pivotal issue before us is whether Appellants have demonstrated that the Examiner erred in determining the obviousness to the skilled artisan of combining the feature code conversion teachings of Shah with the private base communication network teachings of Buhrmann.

¹ The Examiner's statement of the grounds of rejection (Ans. 7-8) includes dependent claim 9 in this rejection. This is an apparent inadvertent error, which we treat as harmless, since claim 9, which is dependent on independent claim 1, has been previously included in the Examiner's rejection based on the combination of Buhrmann and Shah.

FINDINGS OF FACT

The record supports the following relevant findings of fact (FF) by a preponderance of the evidence:

1. Buhrmann discloses (Fig. 1, col. 1, ll. 6-9 and col. 3, ll. 29-39) the connection of first and second communication networks 9 and 14 with a private base 20.
2. Buhrmann further discloses (col. 7, l. 57-col. 8, l. 10) a memory for storing feature codes of the first and second communication networks.
3. Shah discloses (col. 3, ll. 35-53, col. 7, ll. 4-17 and 35-55) discloses a correspondence memory which is utilized to convert user entered codes to establish correspondence between the feature codes of a home network and a visited network.

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (stating that 35 U.S.C. § 103 leads to three basic factual inquiries: the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the art). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie*

case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore,

“‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.”

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Also, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Leapfrog Enter., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1161 (Fed. Cir. 2007) (quoting *KSR*, 550 U.S. at 416). “One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.” *KSR*, 550 U.S. at 419-20.

ANALYSIS

I. The obviousness rejection of claims 1, 2, 9, and 12-16 based on the combination of Buhrmann and Shah.

With respect to the Examiner’s obviousness rejection of representative independent claim 1 based on the combination of Buhrmann and Shah, Appellants’ arguments in response assert a failure by the Examiner to establish a *prima facie* case of obviousness since a proper basis for the

Examiner's proposed combination of references has not been established.² Appellants' arguments focus on the contention that a skilled artisan would not combine Buhrmann and Shah as proposed by the Examiner. According to Appellants (App. Br. 14-18; Reply Br. 8-10), Shah, which teaches conversion between the feature codes of two public base stations, does not remedy the deficiencies of Buhrmann, which lacks any disclosure of any service code conversion between the feature codes of the two networks 9 and 14 connected to the private base station 20. In Appellants' view (*id.*), the public base stations disclosed by Shah have fundamental differences, such as configuration, structure, operating frequencies, etc., than a private base station such as that used by Buhrmann.

We do not find Appellants' arguments to be persuasive of any error in the Examiner's stated position. We agree with the Examiner (Ans. 10 and 13) that Appellants have not shown how any of the alleged fundamental differences between public base stations and private base stations affect the functioning of the feature access codes of the networks connected to the public and private base stations.

We also find to be without merit Appellants' contention (App. Br. 18-20; Reply Br. 5-7) that, even if combined as proposed by the Examiner, the result achieved by the combination of Buhrmann and Shah would not arrive at the claimed invention. It is apparent to us from the Examiner's stated position (Ans. 5 and 12) that the Examiner is not suggesting the bodily incorporation of the public base station network architecture of Shah into the

² Appellant argues rejected claims 1, 2, 9, and 12-16 together as a group. See App. Br. 14-25. Accordingly, we select claim 1 as representative. See 37 C.F.R. § 41.37(c)(1)(vii).

private base station network architecture of Buhrmann. Rather, it is Shah's teaching (col. 3, ll. 35-40 and col. 7, ll. 4-17 and 35-55) of utilizing a feature code conversion correspondence memory between user network codes and visited network codes, thereby avoiding a user's need to memorize the feature codes of different networks, that is relied upon as a rationale for the proposed combination with Buhrmann's private base communication network. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference.... Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art." *See In re Keller*, 642 F.2d 414, 425 (CCPA 1981) and *In re Nievelt*, 482 F.2d 965, 968 (CCPA 1973).

Lastly, we find, contrary to Appellants' arguments (App. Br. 22-24; Reply Br. 5), that the Examiner (Ans. 5, 12, and 15) has set forth an articulated line of reasoning which establishes that the network feature code conversion teachings of Shah would have served as an obvious enhancement to the private base system communication network of Buhrmann. According to the previously discussed *KSR* and *Leapfrog* standards, when a combination of familiar elements according to methods known to the skilled artisan achieves a predictable result, it is likely to be obvious.

For the above reasons, since it is our opinion that the Examiner has established a prima facie case of obviousness which has not been overcome by any convincing arguments from Appellants, the Examiner's 35 U.S.C. § 103(a) rejection of representative independent claim 1, as well as claims 2, 9, and 12-16 not separately argued by Appellants, is sustained.

II. The obviousness rejections of claims 3-8, 10, and 11 based on the combination of Buhrmann and Shah with various secondary references.

The Examiner's obviousness rejections of claims 3-8, 10, and 11 is sustained as well. Appellants (App. Br. 25-27) have made no separate arguments for the patentability of claims 3-8, 10, and 11 but, instead, have relied on the arguments asserted against representative claim 1, which arguments we found to be unpersuasive as discussed supra.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have not shown that the Examiner erred in rejecting appealed claims 1-16 for obviousness under 35 U.S.C. § 103.

DECISION

The Examiner's 35 U.S.C. § 103 rejection of claims 1-16, all of the appealed claims, is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

KIS

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